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GAMDEL, J. EXAMINER

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ART UNIT PAPER NUMBER

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10

1816

DATE MAILED: 10/17/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined

☒ Responsive to communication filed on 6/19/95

☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-4 are pending in the application.

Of the above, claims are withdrawn from consideration.

2. ☐ Claims have been cancelled.

3. ☐ Claims are allowed.

4. ☒ Claims 1-4 are rejected.

5. ☐ Claims are objected to.

6. ☐ Claims are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

15. If applicant desires priority under 35 U.S.C. § 120 based upon a parent application, specific reference to the parent application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. Status of the parent application (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "Patent No." should follow the filing date of the parent application. If a parent application has become abandoned, the expression "abandoned" should follow the filing date of the parent application.

Applicant should indicate the status and relationship of all parent applications on the first line of the specification. Applicant is reminded that PCT/US93/00924 is a continuation-in-part of USSN 07/835,139, which did not recite SEQ ID NOS. The instant claims do have priority back to USSN 07/835,139.

16. Although no IDS has been filed with the instant application, the examiner is providing a copy of the IDS filed with copending USSN 08/456,124 and cites references indicated therein for convenience purposes.

17. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Applicant should indicate the specificity of VLA-4 in the title.

18. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

19. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*,

686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-19 and 21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims (1-12, 14-19, 21) and (1-19, 21, 22) of copending application Serial Nos. (08/284,603) and (08/456,124). This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

21. Claim 20 is provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims (21), (21), (20,21), (20), (20) and (20) of copending application Serial Nos. (08/256,631), (08/374,331), (08/456,193), (08/284,603), (08/456,124), respectively. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented. The claimed inventions are drawn to pharmaceutical compositions consisting essentially of VLA-4-specific antibodies.

A composition is a composition irrespective of what its intended use is. See *In re Tuominen*, 213 USPQ 89 (CCPA 1982).

Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations addressed by the applicant would be inherent properties of the referenced antibodies.

A pharmaceutically acceptable carrier such as PBS was well known in the art as solvent for immunoglobulins for storage as well as immunoassays.

In the possibility that there is an embodiment of the invention that falls within the scope of one claim but not the other; the identical subject matter is not defined by both claims and statutory double patenting would not exist.

It is noted that these claims are composition rather than compound claims, therefore it is possible that the

pharmaceutically acceptable carrier may differ between treating asthma (08/256,631, 08/374,331, 08/456,193) and inflammatory bowel disease (08/284,603, instant 08/373,857, 08/456,124).

Claim 20 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (21), (21), (20,21) of copending application Serial Nos. (08/256,631), (08/374,331), (08/456,193). Although the conflicting claims are not identical, they are not patentably distinct from each other because each composition is drawn to the same active ingredient consisting essentially of VLA-4-specific antibody. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place this antibody in the appropriate pharmaceutical carrier for disease targeted.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

22. Claim 12-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (23-25) of copending application Serial No. 08/456,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to the use a polypeptide that binds VLA-4 including soluble VCAM-1 polypeptides for treating IBD and the copending application is drawn to soluble VCAM-1 polypeptides which are fusion proteins and bifunctional fusion proteins. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the copending fusion proteins and bifunctional fusion proteins for their increase half-life and/or valency for pharmaceutical applications.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 12-21 are directed to an invention not patentably distinct from claims 23-25 of commonly assigned USSN 08/456,193 for the reasons set forth above in this section.

Commonly assigned 08/456,193, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. § 103 if the commonly assigned case qualifies as prior art under 35 U.S.C. § 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 C.F.R. § 1.78(c) to either show that the conflicting inventions were commonly owned at the time

the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. § 103 based upon the commonly assigned case as a reference under 35 U.S.C. § 102(f) or (g).

23. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

24. The specification is objected to and claims 1-21 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention. In evaluating the facts of the instant case, the following is noted:

Applicant has not enabled the breadth of the claimed invention in view of the teachings of the specification. Factors to be considered in determining scope and enablement are: 1) quantity of experimentation necessary, 2) the amount of direction or guidance presented in the specification, 3) the presence or absence of working examples, 4) the nature of the invention, 5) the state of the prior art, 6) the relative skill of those in the art, 7) the predictability or unpredictability of the art, and 8) the breadth of the claims. See Ex parte Forman, 230 USPQ 546, BPAI, 1986.

A) Applicant has not disclosed how to use VLA-4-specific antibodies or fragments thereof alone or combination with other adhesion molecule-specific antibodies therapeutically in humans, as the intended invention. There is insufficient information or nexus of the invention with respect to the in vivo operability of VLA-4-specific immunotherapy with respect to applicant's invention.

Pharmaceutical therapies are unpredictable for the following reasons; (1) the protein may be inactivated before producing an effect, i.e. such as proteolytic degradation, immunological inactivation or due to an inherently short half-life of the protein; (2) the protein may not reach the target area because, i.e. the protein may not be able to cross the mucosa or the

protein may be adsorbed by fluids, cells and tissues where the protein has no effect; and (3) other functional properties, known or unknown, may make the protein unsuitable for in vivo therapeutic use, i.e. such as adverse side effects prohibitive to the use of such treatment. See page 1338, footnote 7 of Ex parte Aggarwal, 23 USPQ2d 1334 (PTO Bd. Pat App. & Inter. 1992).

In vitro and animal model studies have not correlated well with in vivo clinical trial results in patients. Since the therapeutic indices of biopharmaceutical drugs such as antibodies can be species- and model-dependent, it is not clear that reliance on the in vivo inhibition of some aspects of inflammation by the VLA-4- ( $\alpha 4$ -) specific antibody HP1/2 in the experimental tamarin model of IBD accurately reflects the relative efficacy of the claimed therapeutic methods and compositions.

With respect to antibody therapy in general, Harris et al. states that there is widespread acceptance that there is little future for the use of rodent monoclonal antibodies for in vivo human therapy (page 42, column 2) and that repeated dosing with chimeric antibodies is ineffective due to residual anti-idiotypic responses (page 42, column 3) (Tibtech, 1993; 1449, #AS). Humanized antibodies present serious problems with immunogenicity, since the idiotype of such antibodies will contain unique amino acid sequences. Antibodies directed against cell-bound antigens would be expected to be more immunogenic than those binding to soluble antigens. It is well known in the art that the clinical efficacy of antibody therapy including humanized antibodies have been limited by specificity, binding constants, tissue penetration, clearance rates and the mode of action of the effector.

Mountain et al. teach that most antibody-based therapies are very unlikely to achieve success with a single dose (Biotech. Gen. Eng. Rev., page 11, paragraph 1, first sentence, 1993). The success of multiple dosing as a therapeutic regimen alleged by applicant is contrary to that experienced in the art. Murine antibodies are limited to one or perhaps two doses and the administration of further doses leads to accelerated clearance and in many cases to complete abrogation of efficacy (Mountain et al., pages 10-11, overlapping paragraph).

In addressing adhesion-based therapy, Harlan states that whether you go humanized antibody, peptide, soluble receptor, or saccharide; it's still a long way to product (Edgington, Biotechnology, 1992; see entire document, particularly page 386, column 3, paragraph 4). The inherent difficulties of this approach include development of serum sickness after injection of foreign protein, diminishing therapeutic effects after prolonged therapy and the potential for promotion of infection.

Ward et al. addresses the current issues associated with the selection of targeting adhesion molecules as an approach to anti-inflammatory therapy (Therapeutic Immunol., 1994; entire document). There are relatively few conditions in which there is clear-cut evidence of the presence and participation of given adhesion molecules in humans (page 166, column 1, paragraph 1). Also, monoclonal antibodies including antigen-binding fragments thereof are not likely to be the ultimate approach for in vivo blocking of adhesion molecules, even though they will likely provide important information (pages 167-170, particularly Concluding Remarks). In addition, it is pointed out that, in spite of extensive development of peptide analogues for various inflammatory mediators and hormones, few if any of these products have found their way to routine clinical application (page 167, column 1, lines 1-23).

Although the animal models validate concepts based on studies of human disease, such studies are limited to the "acute" as opposed to "chronic" nature of the disease. In animal models, the onset of inflammation is rapid with an aggressive destructive process, whereas in humans the disease progresses more slowly, often with natural periods of disease exacerbation and remission. For example, applicant's reliance on the instant cotton top tamarin model discloses an experimental protocol wherein the HP1/2 antibody is administered one-half hour after the antigen is administered. Amelioration of certain aspects of IBD-associated pathology is much easier to achieve under such controlled conditions to defined antigens associated with the experimental tamarin model than that experienced in the human IBD diseases targeted by the claimed invention.

Applicant relies on the cotton top tamarin IBD model as a well documented model relevant to human IBD. However, Podolsky et al. (Gastroenterology, 1985, particularly the Discussion) indicates that important differences between human disease and the cotton top tamarin disorder makes the equivalence of the animal model to human disease unclear. In addition, Madara et al. (Gastroenterology, 1985, particularly the Discussion) also cite that the absence of an identifiable etiologic factor or a disease-specific marker, makes it difficult to assess the relevance of any potential animal model to the human disorder. Therefore, it is not clear that applicant's reliance on the cotton top tamarin model for human efficacy in the instant invention would be predictive of human therapeutic intervention. IDJ

In contrast to highly defined model of IBD relied upon by applicant, human IBD diseases comprise multiple etiologies or multiple immune responses that makes therapeutic intervention a major hurdle. Furthermore, it is unclear whether such immunotherapy can be used to treat an ongoing inflammatory or immune response (which is the usual case) or whether it is

effective only in terms of prevention. Generally, the chronic and complicated nature of the IBD-type diseases encompassed by the claims are diagnosed only after significant tissue damage has occurred in contrast to the instant tamarin model

In view of the lack of predictability of the art to which the invention pertains the lack of established clinical protocols for effective adhesion-based and antibody-based therapies, undue experimentation would be required to practice the claimed methods with a reasonable expectation of success, absent a specific and detailed description in applicant's specification of how to effectively practice the claimed methods and absent working examples providing evidence which is reasonably predictive that the claimed methods and compositions are effective for treating IBD.

B) VLA-4 and VLA- $\alpha$ 4 comprise multiple receptor-ligand interactions. It is not clear what particular criteria are critical to the VLA-4 or VLA- $\alpha$ 4 specificity of the claimed methods and compositions. For example, it is unclear from the specification whether the claimed methods and compositions can be specific for both  $\alpha$ 4 and  $\beta$ 1 subunits of VLA-4. Is the  $\alpha$ 4 specificity critical or is only certain specific functions or interactions that are critical? VLA-4 can bind both to VCAM and fibronectin. Does one screen for both specificities. Some antibodies block T cell activation others do not.

Does the claimed antibody bind other cell adhesion molecules which comprise  $\alpha$ 4 but a different  $\beta$ . In turn, is the claimed invention drawn to  $\alpha$ 4 or certain epitopes of  $\alpha$ 4, as exemplified by HP1/2, and not necessarily to the broadly claimed VLA-4 specificity per se.

Alternatively, is the  $\beta$ 1 specificity a critical aspect of the claimed VLA-4 specificity? If so, similar questions addressed above concerning  $\alpha$ 4 apply here as well to  $\beta$ 1.

In a further variation, does the claimed VLA-4 specificity refer to a linear epitope that is expressed by either the  $\alpha$ 4 or  $\beta$ 1 chain or to a conformational epitope that requires both  $\alpha$ 4 or  $\beta$ 1 chains?

For example, the specification discloses that the preferred VLA-4-specific antibody embodiments bind B1 or B2 epitopes of the  $\alpha$ 4 chain (specification, page 7). Applicant's claim the VLA-4 specificity as well as a plurality of VLA-4 antibodies.

Applicant discloses the use of HP1/2 antibody, which block leukocyte adhesion to VCAM but does not block other VLA-4-



mediated functions. It is not clear from the that any VLA-4- or VLA-4 $\alpha$ -specificity other than that exemplified by the HP1/2 would serve as candidate therapeutic antibodies. It is not clear that binding and functional attributes of all other VLA-4-specific antibodies would be expected to treat inflammatory bowel disease.

Regarding soluble antagonists in adhesion therapy which would be analogous to the instant VLA/VCAM inhibitors; McCabe et al. teach that soluble ICAM-1, enhances cytokine production while ICAM-1-specific and LFA-1-specific antibodies inhibit such activity (Cell. Immunol., 1993; see entire document).

Furthermore, Sherman-Gold reviews the challenges facing cell adhesion molecule-based therapy and indicates that cell adhesion molecules are complex molecules and the regions crucial to their biological activity have not been fully delineated (Gen. Eng. News, 1993, see entire document, particularly page 6, column 5, paragraphs 1-8; 1449, #CI). Therefore, it would be difficult to design small molecules that will be effective in blocking cell adhesion molecules. Other difficulties include the limited potency of a single adhesion pathway in the face of a number of molecules and alternate pathways and the parameters of the appropriate window for beneficial effects without serious side effects. Sherman-Gold also indicated that the low binding affinity of cell adhesion molecules to their counterparts makes screening for small molecules with biological activity less than a clear cut task (see page 6, column 5, paragraph 6).

It is not clear from the specification what are the critical parameters or endpoints by which one could predict the ability of the claimed antagonists to alleviate or treat asthma. Also, the only working example of in vivo treatment is the use of the HP1/2 VLA-4-specific antibody in an experimental tamarin model and not the use of any VLA-4-specific antibody (different epitope), antibody fragments, soluble polypeptides or small molecules.

In view of the lack of predictability of the art to which the invention pertains the lack of established clinical protocols for effective adhesion-based and antibody-based therapies, undue experimentation would be required to practice the claimed methods with a reasonable expectation of success, absent a specific and detailed description in applicant's specification of how to effectively practice the claimed methods and absent working examples providing evidence which is reasonably predictive that the claimed methods and compositions are effective for treating IBD.

25. The specification is objected to and claim 4 is rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to provide an enabling disclosure, because the specification does

not provide evidence that the claimed biological materials are (1) known and readily available to the public; (2) sequenced; or (3) deposited.

It unclear if cell lines which produce antibodies having the exact structural and chemical identities of HP2/1, HP2/4, L25 and P4C2 antibodies are known and publicly available, or can be reproducibly isolated without undue experimentation. Therefore, suitable deposits for patent purposes is suggested. Without publicly available deposits of the above cell lines, one of ordinary skill in the art could not be assured of the ability to practice the invention as claimed. Exact replication of: (1) the claimed cell lines; (2) cell line which produce the chemically and functionally distinct antibodies claimed; and/or (3) the claimed antibodies's amino acid or nucleic acid sequences is an unpredictable event.

For example, very different  $V_H$  chains (about 50% homologous) can combine with the same  $V_K$  chain to produce antibody-binding sites with nearly the same size, shape, antigen specificity, and affinity. A similar phenomenon can also occur when different  $V_H$  sequences combine with different  $V_K$  sequences to produce antibodies with very similar properties. The results indicate that divergent variable region sequences, both in and out of the complementarity-determining regions, can be folded to form similar binding site contours, which result in similar immunochemical characteristics. [FUNDAMENTAL IMMUNOLOGY 242 (William E. Paul, M.D. ed., 3d ed. 1993)]. Therefore, it would require undue experimentation to reproduce the claimed antibody species HP2/1, HP2/4, L25 and P4C2 antibodies. Deposit of the appropriate hybridomas would satisfy the enablement requirements of 35 U.S.C. § 112, first paragraph. See, 37 C.F.R. 1.801-1.809.

In addition, the identifying information set forth in 37 CFR 1.809 (d) should be added to the specification. See 37 CFR 1.803-1.809 for additional explanation of these requirements.

Amendment of the specification to recite the date of deposit and the complete name and address of the depository is required. As an additional means for completing the record, applicant may submit a copy of the contract with the depository for deposit and maintenance of each deposit.

If the original deposit is made after the effective filing date of an application for patent, the applicant should promptly submit a verified statement from a person in a position to corroborate the fact, and should state, that the biological material which is deposited is a biological material specifically identified in the application as filed, except if the person is an attorney or agent registered to practice before the Office, in which the case the statement need not be verified. See MPEP

1.804(b).

It is noted that the provision of SEQ ID NOS 1-4 which encode the claimed HP1/2 antibody obviates a rejection based upon the deposit of this biological material. The HP1/2 antibody is required for the enablement of the claimed invention (claims 4, 5, 13, 16, 20).

26. Claims 14-15 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 14 is indefinite in the recitation of "plurality of anti-VLA-4 monoclonal antibodies" because it is not clear what is meant by this phrase. Does this refer to a plurality of VLA-4 antibodies that bind a single epitope (B1 vs. B2, page 7, paragraph 1 of the specification) or a single antigen (e.g.  $\alpha 4$  vs.  $\beta 1$  specificity of VLA-4) or different forms of the same epitope-/antigen-specific antibody (e.g. monoclonal vs. chimeric) or simply more than one antibody molecule. While the specification appears to refer to the use of VLA-4 antibodies, it is not clear what is the antecedent basis with respect to the metes and bounds of "a plurality of VLA-4 monoclonal antibodies". Only the VLA-4-specific HP1/2 antibody was tested in a tamarin model of IBD. For the reasons discussed above in section 21, it is not clear whether any VLA-4-specific antibodies would work therapeutically in IBD observed in humans. Therefore it is not clear from the evidence of record that combinations of different epitope-/ antigen-specific antibodies would work. No clear direction or guidance is provided to assist one skilled in the art in the selection of the appropriate "plurality" of VLA-4-specific antibodies to treat IBD nor is there evidence provided that any such plurality would be therapeutically effective in the treatment of inflammatory bowel diseases. It appears that undue experimentation would be required of one skilled in the art to practice the claimed methods using the teaching of the specification alone.

If applicant's intention is only to indicate the various antibody forms claimed in claim 12, then "plurality of said anti-VLA-4 monoclonal antibodies" would obviate this rejection.

B) Claim 15 is indefinite in the recitation of "an anti-CDX antibody" because its characteristics are not known. Although anti-CDX is disclosed on page 12, line 4 of the specification, this anti-CDX specificity reads on apparently all CD antigens. This language is vague and indefinite since it encompasses

minimally over a hundred CD antigens, potentially thousands of different epitopes and specificities and it is not apparent from the disclosure which particular CD specificities or epitopes are being referred to. Not all CD specificities would be appropriate for targeting in the treatment of inflammatory bowel disease. No clear direction or guidance is provided to assist one skilled in the art in the selection of the appropriate CDX-specific antibody nor is there evidence provided that any such CDX-specificity would be therapeutically effective in combination with VLA-4-specific antibodies in the treatment of inflammatory bowel diseases. It would require undue experimentation to produce all such possible anti-CDX specific antibodies without more explicit guidance from the disclosure.

C) The amendments must be supported by the specification so as not to add any new matter.

27. Claims 1-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claims 1-11, 14, 17-19 and 21 are indefinite in the recitation of "composition". Minimally the therapeutically effective amount of the active ingredient and the pharmaceutically acceptable carrier should be recited in the claims. The specific function of the composition may also be included as well.

B) Claims 14 and 17-19 are indefinite in that they lack antecedent basis for "composition".

C) Claim 15 is indefinite in the recitation of "any such" as "said" is the more appropriate term for antecedent basis.

D) Claim 7 is indefinite in the recitation of "antibody" because "said antibody" or "anti-VLA-4 antibody" would be consistent with the appropriate antecedent basis. The plasma comprises various antibodies.

E) Claims 3, 4, 13, 16 and 21 are indefinite in the recitation of "HP2/1, HP2/4, L25 and P4C2" because their characteristics are not known. The use of "HP1/2, HP2/1, HP2/4, L25 and P4C2" monoclonal antibodies as the sole means of identifying the claimed antibodies renders the claims indefinite because these terms are merely laboratory designations which do not clearly define the claimed products, since different laboratories may use the same laboratory designations to define completely distinct cell lines.

F) Claims 12-20 are indefinite in the recitation of "chimeric" and "recombinant" antibody because it is not clear what are the metes and bounds of either.

G) Claims 16 and 21 are duplicative of one another and applicant should cancel one or the other.

The amendments must be supported by the specification so as not to add any new matter.

28. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

29. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

30. Claim 20 is rejected under 35 U.S.C. § 102(a) as being anticipated by Wayner et al. (WO 91/03252). Wayner et al. teach  $\alpha 4\beta 1$ -specific antibodies including P4C2 as pharmaceutical compositions (see entire document, particularly page 28-29). Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations addressed by the applicant (e.g. for the treatment of IBD) would be inherent properties of the referenced antibodies.

31. Claim 20 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Elices et al. (Cell, 1990, see entire document; 1449, #AQ). Claim 20 is drawn to VLA-4-specific antibodies in a pharmaceutical composition. VLA-4-specific antibodies, including the claimed HP2/1 antibody, are taught in the reference as well as their use in several assays including adhesion inhibition assays and flow cytometry. The antibodies were suspended in PBS/BSA/HS for the flow cytometry assays and it is not clear what diluent was

employed in the adhesion inhibition assays. However, a pharmaceutically acceptable carrier such as PBS was well known in the art as solvent for immunoglobulins for storage as well as immunoassays. Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations would be inherent properties of the referenced antibodies. A composition is a composition irrespective of what its intended use is. See In re Tuominen, 213 USPQ 89 (CCPA 1982).

It is the burden of the applicant to show the unobvious difference between the claimed and disclosed antibody compositions. See In re Best, 195 USPQ 430, 433 (CCPA 1977) and In re Marosi, 218 USPQ 289, 292-293 (Fed. Cir. 1983).

32. Claim 20 is rejected under 35 U.S.C. § 102(e) as being anticipated by Hession et al. (U.S. Patent No. 5,272,263). Hession et al. teach the VLA-4-specific antibodies including HP1/3 (column 30) and the use of such antibodies in various assays and in therapy (see columns 12-14, for example). Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations would be inherent properties of the referenced antibodies. A composition is a composition irrespective of what its intended use is. See In re Tuominen, 213 USPQ 89 (CCPA 1982).

33. Claims 1-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Osborn (Cell, 1990; 1449, #BO) in view of Hemler et al. (Immunol. Rev., 1990), Holzmann et al. (Immunol. Rev., 1989; 1449, #AU) and Sanchez-Madrid et al. (Eur. J. Immunol., 1986; 1449, #CG) and Hession et al. (U.S. Patent No. 5,272,263). Claims 1-21 are drawn to treating inflammatory bowel disease with anti-VLA-4 monoclonal antibodies, fragments, soluble VCAM and small molecules and VLA-4-specific antibody compositions.

Osborn teaches the potential of interfering with leukocyte-endothelium interactions with adhesion-blocking reagents such as antibodies that will bind adhesion molecules (receptor or ligand) as a therapeutic means to reduce or to prevent leukocyte-mediated diseases such as inflammatory bowel diseases (see page 6). There is no evidence that the method of use described in the instant claims would differ in an unexpected manner from those described in the reference. Osborn teaches the invention substantially as claimed to use anti-VLA-4 antibody compositions to treat inflammatory bowel diseases therapeutically. Osborn does not exemplify the therapeutic use of anti-VLA-4 monoclonal antibodies as a method of treating inflammatory bowel diseases. In

addition, Osborn teaches VLA-4 has more than one binding site (e.g. VCAM and fibronectin, page 6). It is noted that Osborn points out that the murine homolog of VLA-4 as well as human VLA-4 is involved in lymphocyte homing to Peyer's patches as was shown by antibody inhibition studies (page 5, column 2, paragraph 3, see Holzmann et al.). This homology refers to the  $\alpha 4$  component of VLA-4. Holzmann et al. teaches the ability of LFA-2 and LPAM-2/VLA-4 specific antibodies to block leukocyte homing to mucosal tissues (see page 56, paragraph 1). In further consideration of the Osborn teaching of multiple adhesion interventions and the diverse cellular populations contributing to inflammatory bowel disease, it would have been obvious to target several adhesion molecule specificities to ameliorate the inflammatory response contributed by various leukocyte populations. As indicated, Holzmann et al. does teach the ability of both VLA-4-/LFA-1-specific antibodies to inhibit mucosal trafficking by leukocytes.

Hemler et al. reviews the structure and multiple functions of VLA-4 in cell-cell and cell-matrix interactions and the ability to block these interactions and functions with VLA-4-specific antibodies (see entire document). In addition to inhibiting adhesion, leukocyte activation and hence the elaboration of various cytokines are also inhibited. Hemler et al. also cites Sanchez-Madrid et al. as the source of the instant VLA-4-specific antibodies (see entire document including References).

Hession et al. teach the role of adhesion molecules including the instant VLA, VCAM, ELAM and ICAM in leukocyte adhesion and infiltration of inflammation. The procedures for preparing of VLA-4-specific antibodies (column 30), soluble adhesion proteins (column 13, lines 47-61 and columns 31-32, Example XV) and the screening procedures for adhesion inhibitors (column 31, Example XIV).

Sanchez-Madrid et al. exemplify the production of anti-VLA-4 monoclonal antibodies which includes some the preferred embodiments of the instant invention including HP1/2, HP2/1 and HP2/4 of the present invention (see claims 3, 13, 16, 21). These VLA-4 antibodies have specificity for the  $\alpha 4$  component of VLA-4.

Inflammatory bowel diseases comprise ulcerative colitis and Crohn's Disease. The treatment of acute or chronic disease by the IBD patient would have been similarly addressed by treating IBD with VLA-4-mediated therapy to diminish leukocyte accumulation and activation, as disclosed by Osborn. In a similar vein to increase the efficacy of anti-adhesive or anti-inflammatory therapy, the ordinary artisan would have used VLA-4-

specific antibodies alone in combination with other adhesion molecule specificities (e.g. LFA-1) to target all of the contributing leukocyte populations that contribute to mucosal inflammatory reactions. The claimed limitations of the therapeutic methods of administration and dosage of antibodies cited in the instant as the preferred embodiments were routine and obvious in the art, as determined by the physician (specification, page 8, paragraph 2). The claimed limitations of various biologically active antibody fragments, chimeric and recombinant (e.g. humanized) antibodies and antibody compositions and combinations were routine and obvious in the art (specification, pages 10-11 and taught by Hession et al., for example).

One of ordinary skill in the art at the time the invention was made would have been motivated to select and evaluate the efficacy of VLA-4-specific immunotherapy with VLA-4-specific (e.g.  $\alpha 4$ -specific) antibodies as a therapeutic regimen in treating human inflammatory bowel disease. Further, the use of VLA-4-specific antibodies alone or in combination with other adhesion molecule specificities would have evaluated to increase the efficacy of anti-adhesive/anti-inflammatory therapy. From the teachings of the references, it was apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

34. Claims 1-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Osborn (Cell, 1990) in view of Hemler et al. (Immunol. Rev., 1990), Holzmann et al. (Immunol. Rev., 1989), Hession et al. (U.S. Patent No. 5,272,263) and Sanchez-Madrid et al. (Eur. J. Immunol., 1986) as set forth to claims 1-21 above and in further view of Issekutz (J. Immunol., 1991; 1449, #BB) and (Salmi et al. (Gastro. Clinics of N. Am., 1991; 1449, #CF). Claims 1-21 are drawn to treating inflammatory bowel diseases with anti-VLA-4 monoclonal antibodies and VLA-4 antibody compositions.

Osborn, Hemler et al., Holzmann et al., Hession et al. and Sanchez-Madrid et al. are taught supra in section 33.

The addition of Issekutz et al. and Salmi et al. are to provide further evidence with respect to the role of adhesion molecules in mucosal trafficking and inflammatory bowel disease.

Issekutz teach the in vivo ability of  $\alpha 4$ -specific antibodies to inhibit lymphocyte migration into inflamed tissues and inhibits normal lymphocyte recirculation into mesenteric nodes



and intestinal Peyer's patches as well (see entire document, particularly page 4183, column 2, paragraph 1).

Salmi et al. suggest the therapeutic manipulation of the pathologic characteristics of the immune response in inflammatory bowel diseases, which prevents leukocyte migration into inflammatory sites through receptors such as VCAM-1, ELAM-1 and ICAM-1. Salmi et al. teach that VLA-4 is involved in human lymphocyte binding to mucosal endothelium (page 499) and lamina propria lymphoblasts do express VLA-4 alpha-chain (page 505). Salmi et al. teach that leukocytes expressing VLA-4 would have the ability to bind either to the activated endothelium on blood vessels or to fibronectin within the tissue (page 499). Salmi et al. also teach VCAM-1 (VLA-1 ligand) is expressed in vivo on some arterial endothelium, some post-capillary venules, small vessels and cells of dendritic morphology and in vitro on activated endothelium (page 503). Therefore, Salmi et al. teach multiple adhesion specificities are involved in leukocyte migration and interaction in gastrointestinal tissues and, as such, would be targets for therapeutic intervention in combination therapy.

Applicant's claims are essentially met by these references, as indicated above in section 33.

One of ordinary skill in the art at the time the invention was made would have been motivated to select and evaluate the efficacy of VLA-4-specific immunotherapy with VLA-4-specific ( $\alpha 4$ -specific) antibodies as a therapeutic regimen in treating human inflammatory bowel disease. Further, the use of VLA-4-specific antibodies alone or in combination with other adhesion molecule specificities would have evaluated to increase the efficacy of anti-adhesive/anti-inflammatory therapy. From the teachings of the references, it was apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

34. No claim is allowed.

35. Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CMI Fax Center telephone number is (703) 308-4227.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip

Serial No. 08/373857  
Art Unit 1816

18

Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Margaret Parr can be reached on (703) 308-2454. The fax phone number for Group 1800 is (703) 305-3014 or (703) 308-4227. The fax phone number for Art Unit 1816 is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'P. Gambel' with a stylized flourish at the end.

Phillip Gambel, Ph.D.  
Patent Examiner  
Group 1800  
October 14, 1995